

### **REMARKS/ARGUMENT**

Claims 1, 11-23, 33-38, 40-41, 44, and 46-54 are pending after entry of the present Amendment.

Applicants are filing this response within two months of the date of mailing of the Final Office Action in conformance with MPEP Section 714.13. A response in accordance with this section is kindly requested.

#### **Claim Objections**

Claim 53 was objected to because of noted informalities. Claim 53 is herein amended to correct the informalities as required. Applicants request that the claim objection be withdrawn.

#### **Rejections under 35 U.S.C. §103**

Applicants' claims 1, 11, 12, 23, 33, 46-48, and 53-54, were rejected under 35 USC §103(a) as being unpatentable over Joffe et al., (U.S. Patent No. 6,185,619) in view of Adams (US Patent No. 6,055,568). The claim rejections are traversed, and Applicants request reconsideration in light of claim amendments and argument.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. (MPEP §2143). The mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggest the desirability of the combination. That is, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. Applicants respectfully submit a *prima facie* case of obviousness is not supported against Applicants' claimed invention.

Regarding Applicants' independent claim 1, Applicants respectfully submit that the asserted combination fails to teach or suggest all the claim limitations as recited.

Specifically, The office asserts that Joffe et al. teach collecting data, including a network location of each of the plurality of computers, and cites col. 10, line 65-col. 11, line 4. In the cited section Joffe et al. do not teach collecting a network collection of each of the plurality computers. Rather, “routing configuration is set up once for each system during installation. The Director has access to a table of IP addresses for each content server” (col. 10, lines 65-67). Applicants claim collecting data about a plurality of computers within a peer-to-peer network, a dynamic environment in which hosts and configurations are constantly changing, and in which a network location for any of the plurality of computers can and does as the network changes. In the client-server environment of Joffe et al., the more static environment is sufficiently managed by listing (in a table) the IP addresses of each content server. Further, the Director doesn’t *collect* data including a network location of each of the plurality of computers, but *has access to* a table in which the data is listed. The asserted combination, therefore, at least does not teach or suggest all the claim limitations as recited in Applicants’ independent claim 1.

Further, the asserted combination lacks the suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Although the Office has asserted that “the peer-to-peer architecture of Adams in the process of searching in Joffe et al. because such a peer-to-peer architecture would allow a search to be performed by a large number of systems in which the load on the network is widely distributed and balanced, thereby resulting in better performance and response times.” Applicants respectfully disagree with the Office’s assertions on several grounds. As described previously in an earlier amendment, peer-to-peer networks and client-server networks are fundamentally different approaches, but both result in networks. Both peer-to-peer and client-server networks existed at the time of invention. Motivation to combine, if any were to exist, would be accessible, but generally such motivation would not exist. Because the approaches to networking of the peer-to-peer and the client-server models are fundamentally different, one would normally choose one or the other, as both approaches offer unique advantages. However, it is not true that peer-to-peer architecture allows better performance and response times than client-server. See Applicants’

Background as originally filed. It is fundamentally not true that the peer-to-peer architecture of Adams in the process of searching in Joffe et al. would result in better performance and response times. In addition to being an incorrect statement of network architecture and process, there is no support for such motivation found in either reference, or in the knowledge generally available to one of ordinary skill in the art.

Regarding claim 23, Joffe et al. fails to teach a database which stores the data collected by the profiler.

For at least the above reasons, Applicants respectfully request reconsideration of the rejection of claims 1, 11, 12, 23, 33, 46-48, and 53-54, and that the rejection be withdrawn.

Applicants' claims 13, 14, 16, 17, 19-21, 34-35, 38, 40, 41, 49, 50, and 52, were rejected under 35 USC §103(a) as being unpatentable over Joffe et al. in view of Adams, in further view of Hirosawa et al. (U.S. Patent No. 6,718,391). The claim rejections are traversed, and Applicants request reconsideration in light of claim amendments and argument.

Applicants respectfully submit that the foundational asserted combination of Joffe et al. in view of Adams is flawed for the reasons set forth above. Hirosawa et al. teach another client-server network, as in Joffe et al., and is used essentially to supply the missing pieces of information about content, periodic common requests, and caching. However, the asserted motivation for attributing the features of removing content data after a predetermined period of time was that it was recognized in the art at the time of the invention. Applicant respectfully disagrees and requests reconsideration, or at least some objective proof of such an assertion. It may have been recognized that content was only replaced with newer content. The rejection was as unpatentable over Joffe et al. in view of Adams in further view of Hirosawa et al. It is *that* asserted combination that must have the motivation to combine, and *that* asserted combination that must teach or suggest all the claim limitations. Applicants respectfully submit that the Office has failed to establish a *prima facie* case for obviousness.

Specifically addressing the motivation to combine, the Office actually doesn't provide motivation for the Hirosawa et al. portion of the asserted combination, other than

the statement "It would have been obviousness to one having ordinary skill in the art at the invention was made to readily recognize that the cache mechanism includes removing content data after a predetermined period of time in order to minimize the probability that users will access stale data." In addition to Applicants' challenge of the validity of the statement, Applicants further question whether this statement is the asserted motivation to combine references. While Applicants recognize that the Office can probably go out and find individual pieces and parts of the claim features, the fundamental hurdle of articulating motivation, found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggest the desirability of the combination (MPEP §2143).

Applicants' claims 18 and 36 were rejected under 35 USC §103(a) as being unpatentable over Joffe et al., in view of Adams, in view of Hirosawa et al., in further view of Scharber (U.S. Patent No. 6,542,964). The claim rejections are traversed, and Applicants request reconsideration in light of claim amendments and argument.

According to the Office, the patent to Scharber is combined with the asserted combination of Joffe et al. in view of Adams, in view of Hirosawa et al., as the initial combination fails to teach or suggest storing a portion of the content data claimed. Applicants respectfully submit that the patent to Scharber also fails to teach that which is claimed by Applicants in claims 18 and 36. Applicants claim collecting data about a plurality of computers within the peer-to-peer network, storing the collected data in a memory wherein at least a portion of the collected data is content data, and storing a portion of the content data which identifies a type of file available for searching on the plurality of computers. According to the cited portions of the Scharber reference, cache servers are organized according to content, with specified data associated with particular servers. The reference does not teach the collecting of data which includes content information, and storing content information which identifies a type of file available for searching on the plurality of computers.

As described above, the further combination to add further pieces and parts found in Applicants' claims still does not solve the lack of motivation. For at least the above

reasons, Applicants submit that claims 18 and 36 are patentable under 35 USC §103(a) over the asserted combination of references, and request that the rejections be withdrawn.

Applicants' claims 15, 37, and 51 were rejected under 35 USC §103(a) as being unpatentable over Joffe et al., in view of Adams, in view of Hirosawa et al., in further view of Ishikawa et al. (JP 11015707). The claim rejections are traversed, and Applicants request reconsideration in light of claim amendments and argument.

For at least the reasons submitted above, Applicants submit that the Office has failed to establish a *prima facie* case of obviousness as no viable motivation to combine has been articulated. Applicants therefore respectfully request that the rejections of claims 15, 37, and 51 be withdrawn.

Applicants' claims 22 and 44 were rejected under 35 USC §103(a) as being unpatentable over Joffe et al., in view of Adams, in further view of Nagae (U.S. Patent No. 6,006,248). The claim rejections are traversed, and Applicants request reconsideration in light of claim amendments and argument.

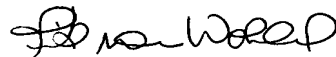
Applicants respectfully submit that the asserted combination, continuing to lack the requisite motivation to combine, further fails to teach or suggest all the claim limitations of Applicants' claims 22 and 44. Specifically, the Office has asserted that the patent to Adams teaches collecting data about a predetermined number of the plurality of computers at a first predetermined time interval at Fig 1, and col. 6, lines 48-50. Figure 1 shows several exemplary computer systems implementing an embodiment of the Adams invention. Col. 6, lines 48 -50 recite: "Alternatively, the steps of the present invention may be performed intermittently beset on a pre-determined time period." Even if the cited sections are interpreted to teach a first predetermined time interval, the asserted combination fails to teach or suggest *a predetermined number* of the plurality of computers.

For at least the reasons that the asserted combination fails to teach or suggest all claim limitations as recited in Applicants' claims 22 and 44, and for the utter failure to provide supportable motivation to combine, Applicants respectfully submit that claims 22 and 44 are patentable under 35 USC §103(a) over the asserted combination, and request that the rejections be withdrawn.

Appl. No. 09/635,777  
Amdt. dated August 9, 2004  
Reply to Office Action of June 8, 2004

In view of the foregoing, Applicants respectfully request reconsideration of claims 1, 11-23, 33-38, 40-41, 44, and 46-54. Applicants submit that all claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. If Examiner has any questions concerning the present Amendment, the Examiner is kindly requested to contact the undersigned at (408) 749-6900, ext. 6905. If any additional fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. ROXIP280). A copy of the transmittal is enclosed for this purpose.

Respectfully submitted,  
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